



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,519	01/21/2004	Jose Rojas Ubilla	24627-1002	4266

7590 08/21/2006  
Brandon N. Sklar  
Kaye Scholer LLP  
425 Park Avenue  
New York, NY 10022-3598

EXAMINER

MILLER, ROBERT J

ART UNIT PAPER NUMBER

3635

DATE MAILED: 08/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/761,519

Applicant(s)

UBILLA, JOSE ROJAS

Examiner

Robert J. Miller

Art Unit

3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 21 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date, \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

This is a first Office action on the merits for application serial number 10/761,519 filed January 21, 2004. Claims 1-21 are pending.

#### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the varying thickness – claims 5 and 16, joining means – claims 1,4,8,10,15,17, and 19, arranged in mismatched manner – claim 6, seal – claim 20, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an

application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9, and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

Regarding claim 7, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim 1 recites the limitation "the respective joining means" in line 5. There is insufficient antecedent basis for this limitation in the claim.

All depending claims from claim 1 are thereby inherently vague and indefinite.

The term "mismatched manner" in claim 6 is a relative term which renders the claim indefinite. The term "mismatched manner" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: first, second, third, and fourth open cross-section elongated members and the hollow transversal section of claim 10.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 7, 8, 10-13, 15, 16, 18, 19, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by US 2,975,874 Pagan.

In regard to claim 1, as best understood, the beam is fabricated from two c-type elongated members [1,1a] joined together to form hollow transversal section.

In regard to claim 2, as best understood, the beam has stiffened cores 4,4a.

In regard to claim 3, as best understood, the beam may be widely varied (diverse) in scope [c2, l26].

In regard to claim 4, as best understood, the beam components are joined by welding [c2, l1].

In regard to claim 5, as best understood, the beam structural member has varying thickness [c2, l32].

In regard to claim 7, as best understood, the beam is made of steel [c1, l31].

In regard to claim 8, as best understood, the beam joint means by welding, riveting, bolting [c2, l1-3].

In regard to claim 10, structural element comprising two elongated members having c-type [c1, l16] joined together [c2, l1] to form a hollow transversal section.

In regard to claim 11, the elongated members have rounded bends [see figure].

In regard to claim 12, the elongated members have stiffened edges [3,3a].

In regard to claim 13, the elongated members have stiffened cores [4,4a].

In regard to claim 15, joining means comprising welding [c2, l1].

In regard to claim 16, elongated members have varied thickness [c2, l32].

In regard to claim 18, elongated members are metal [c1, l31].

In regard to claim 19, joining means is riveting [c1, l2].

In regard to claim 21, manufacturing a structural element from two elongated members and joining to form a hollow transversal section [c1, l42-49].

Claims 10 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,464,302 Menchetti.

In regard to claim 10, Menchetti '302 discloses two elongated c-type members 10 interconnected to form a hollow transversal section.

In regard to claim 14, Menchetti '302 shows where the elongated members have unequal dimensions [fig 3].

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 9 and 20, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Pagan '874 in view of US 4,002,000 Howard et al. Pagan discloses all the limitations of the above referenced claim except the joint between the elongated members is completed throughout their full extension. Howard et al '000

teaches a closed beam [c1, l66] of two elongated members welded together [fig 4, c2, l53-55] to form a seal between the two members. It would have been obvious at the time of the invention to one having ordinary skill in the art to have utilized the joining taught by Howard et al '000 to close the girder of Pagan '874 in order to prevent corrosion and thereby increase the length of time the girder of Pagan will remain functional.

Claims 6 and 17, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Pagan '874 in view of US 3,606,418 Buker et al. Pagan '874 discloses all the limitations of the above referenced claims except having elongated members joined end to end and corresponding elongated members joined end to end wherein the joined elongated sections are mismatched such that the end to end joints do not coincide in a common transversal section. Buker et al teaches a lapped or spliced joint [c2, l5-16] for a c-channel member for providing a structurally continuous member [c4, l38-48]. It would have been obvious at the time of the invention to one having ordinary skill in the art to have utilized the teaching of Buker et al to lengthen the beam of Pagan '874 when necessary thereby eliminating the need for producing beams of extended length made of only a single section of metal.

### ***Conclusion***



The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert J. Miller whose telephone number is 571-272-1782. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Naoko Slack can be reached on 571-272-6848. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



rjm



N. Slack  
SPE